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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,858	11/05/2003	Thomas J. Staunton	7455	7797

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EXAMINER

EGWIM. KELECHI CHIDI

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/701,858

Applicant(s)

STAUNTON ET AL.

Examiner

Dr. Kelechi C. Egwim

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>031504 & 080304</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18, drawn to a curable solvent solution composition, classified in class 525, subclass 123.
 - II. Claim 19, drawn to a substrate prepared by coating and curing at least one coating comprising the curable solvent solution composition of group I, classified in class 428, subclass 422.8.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a coating on or with other than pigmented basecoats and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the

Art Unit: 1713

evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Robert E. McDonald on 2/7/05, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-18. Affirmation of this election must be made by applicant in replying to this Office action. Claim 19 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 11-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. The phrase "preferably less than 2,400" in claim 11, from which claims 12-18 depend, renders the claims indefinite because it is unclear whether the limitation in the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 1713

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-18 are rejected under 35 U.S.C. 102(a or e) as being anticipated by Lewin et al. (USPN 6,326,059).

In col. 1, lines 55-65 and col. 7, lines 23-56, Lewin et al. teach a curable composition comprising a solvent solution of a mixture comprising:

- (i) a hydroxy-functional acrylic polymer;
- (ii) low molecular weight polyol reactive diluent;
- (iii) at least one polyisocyanate;
- (iv) a metal catalyst for accelerating the reaction; and
- (v) an acid such as propionic acid.

The catalyst is exemplified in the examples by tin compounds.

Thus, the requirements for rejection under 35 U.S.C. 102(a or e) are met.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (USPN 3,808,162).

In col. 2, lines 28-33, col. 3, lines 22-30, col. 5, lines 20-27 and col. 6, line 51 to col. 7, line 15, Allen et al. teach curable compositions comprising a solvent solution of a mixture comprising:

- (i-ii) hydroxy-functional organic compounds, including hydroxy-functional acrylic polymers and other polyols for reacting with the isocyanates;
- (iii) at least one polyisocyanate;
- (iv) a metal catalyst such as stannous octoate for accelerating the reaction; and
- (v) an acid such as propionic acid.

The reference differs from the claimed subject matter in that a single embodiment featuring all of applicant's claimed limitations is not included. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at applicant's invention because the claimed subject matter falls within the generic embodiments of the prior art and the person of ordinary skill in the art would have expected all the embodiments of the prior art to work successfully.

Further, suitable hydroxy-functional compounds for the process as disclosed by Allen et al. are said to include both the low molecular weight polyol compounds and the hydroxy-functional acrylic polymers. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a combination of the low molecular weight polyol compounds and the hydroxy-functional acrylic polymers as hydroxy-functional compounds in Allen et al. since each member of the combination is known individually as a isocyanates reactive hydroxy-functional compound and a person of ordinary skill in the art at the time the invention was made would have

Art Unit: 1713

expected such a combination to work in an additive or cumulative manner, In re Kerkhoven, 205 USPQ 1069 (CCPA 1980).

15. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moribe et al. (JP 05093028) in combination with Allen et al. or Lewin et al.

In the abstract, Moribe et al. teach a curable composition comprising a solvent solution of a mixture comprising:

- (i) a hydroxy-functional acrylic polymer;
- (iii) at least one polyisocyanate;
- (iv) an organotin catalyst for accelerating the reaction; and
- (v) an acid such as propionic acid.

Moribe et al. differ from the claimed invention in that they do not mention low molecular polyol compounds. However, it is known in the art to incorporate such polyols in the OH-isocyanate curable solutions, for the purpose of promoting the reaction to form the polymer product, such as taught by Allen et al. (col. 2, lines 10-15) or Lewin et al. (col. 7, lines 44-55), above.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to include low molecular with polyol compounds in the curable composition of Moribe et al., motivated by a reasonable expectation of success, as per the teachings in Allen et al. or Lewin et al.

Art Unit: 1713

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER

KCE

A handwritten signature in black ink, appearing to be 'KCE' or a stylized version of the name, written over a horizontal line.